

REMARKS

Claims 18-22 and 24-34 remain pending, with claims 29-33 withdrawn from consideration, and claims 18-22, 24-28, and 34 under current examination. Applicants have amended claims 18, 19, 25, and 26. Support for the amendments may be found in the specification at, for example, at page 8, lines 14-22 and page 16, line 13 - page 17, line 20.

Applicants respectfully traverse the rejections made in the Office Action mailed September 29, 2011, wherein the Examiner:

- (1) rejected claims 18-20 and 24-28 under 35 U.S.C. § 101 as being directed to non-statutory subject matter;
- (2) rejected claims 18, 24-28, and 34 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent App. Pub. No. 2003/0115421 ("*McHenry*") in view of U.S. Patent App. Pub. No. 2002/0152318 ("*Menon*"), U.S. Patent App. Pub. No. 2002/0010798 ("*Ben-Shaul*"), and U.S. Patent App. Pub. No. 2003/0028564 ("*Sanfilippo*");
- (3) rejected claims 19 and 20 under 35 U.S.C. § 103(a) as being unpatentable over *McHenry* in view of *Menon*, *Ben-Shaul* and *Sanfilippo*, and further in view of U.S. Patent No. 6,829,613 ("*Liddy*");
- (4) rejected claim 21 under 35 U.S.C. § 103(a) as being unpatentable over *McHenry* in view of *Menon*, *Ben-Shaul* and *Sanfilippo*, and further in view of U.S. Patent App. Pub. No. 2002/0062300 ("*Asadov*"); and
- (5) rejected claim 22 under 35 U.S.C. § 103(a) as being unpatentable over *McHenry* in view of *Menon*, *Ben-Shaul*, *Sanfilippo*, and *Asadov*, and further in view of U.S. Patent App. Pub. No. 2002/0188681 ("*Gruen*").

I. Rejection of Claims 18-20 and 24-28 under 35 U.S.C. § 101

The Office Action applied the "machine-or-transformation" test and alleged that "steps of the method are not tied to a particular machine or apparatus, and do not particularly transform a particular article to a different state or thing." Office Action, p. 8. In response, Applicants note that the *Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View*

of *Bilski v. Kappos*, Docket No. PTO-P-2010-0067, “provides factors to consider in determining subject matter eligibility of method claims,” and states that the machine-or-transformation test “is not the sole test for deciding whether an invention is a patent-eligible ‘process.’” 75 Fed. Reg. 43922-43924 (July 27, 2010), quoting *Bilski v. Kappos*, 561 U.S. ___, Slip Op. at 8 (2010). According to the *Interim Guidance*, claims should not be rejected under 35 U.S.C. § 101 if there is a “clear indication that the method is not directed to an abstract idea.” *Id.* In particular, claim 18 recites elements that are clearly not directed to abstract idea, and thus, should be allowable under § 101 without further amendment.

Nonetheless, to advance prosecution, Applicants have amended claim 18 to recite “a control system,” which is a statutory “machine” under 35 U.S.C. § 101. Support for the amendments can be found in the originally filed Specification, for example, at page 8, lines 14-22. Because claim 18 is drawn to statutory subject matter, dependent claims 19, 20, and 24-28 also recite statutory subject matter. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 18-20 and 24-28 under 35 U.S.C. § 101.

II. Rejections of Claims 18-22, 24-28, and 34 under 35 U.S.C. § 103(a):

Applicants request reconsideration and withdrawal of the rejections of claims 18-22, 24-28, and 34 under 35 U.S.C. § 103(a) as being unpatentable over *McHenry*, in view of one or more of *Menon*, *Ben-Shaul*, *Sanfilippo*, *Liddy*, *Asadov*, and *Gruen*. See Office Action, pp. 9-19.

Contrary to the assertions of the Office Action, the recited references, taken alone or in any combination, do not teach or suggest at least the following features of amended claim 18, for example:

dynamically retrieving a set of semantics from the distributed contents as a set of categories;

...

receiving an input of a first interest threshold and a second interest threshold greater than the first interest threshold;

identifying, by the control system, at least one first category and at least one second category, from said set of categories, when the distributed contents associated with the first category have an interest value below the first interest threshold and the distributed contents associated with the second category have an interest value that exceeds the second interest threshold;

removing the distributed contents associated with the first category from the surrogate servers; and

making at least one of the identified contents associated with said second category available for distribution at the surrogate servers.

Instead, *McHenry* discloses an “operating environment 10 ... providing for ... distribution of content throughout a geographically distributed enterprise.” *McHenry*, paragraph [0025]. The operating environment disclosed by *McHenry* includes “[o]ne or more content origin server systems...[that] provide content,” and “[e]nterprise network edge servers 22, 24...[that] transfer requested content to the clients 16, 18.” *Id.* “[V]arious operational information, such as content and user access frequencies and response performance, are reported back by the enterprise network edge servers 22, 24.” *McHenry*, paragraph [0031]. “The content objects are then grouped 94 for purposes of assigning action rules 96 in common to grouped objects.” *McHenry*, paragraph [0041].

The Office Action alleged that *McHenry*’s “a plurality of content groups” (*McHenry*, paragraph [0013]) correspond to the claimed “set of categories.” *See* Office Action, p. 10. This allegation is incorrect. *McHenry*’s “content groups” do not constitute the claimed “set of categories,” because *McHenry*’s “content groups” are defined based on “predefined set of domain content identifiers” (*McHenry*, paragraph [0013]), rather than being obtained by “dynamically retrieving a set of semantics from the distributed contents,” as recited by amended claim 18.

Furthermore, *McHenry* does not teach or suggest “receiving an input of a first interest threshold and a second interest threshold greater than the first interest threshold,” as recited by amended claim 18. Indeed, the Office Action conceded that *McHenry* “does not explicitly disclose receiving an input of an interest threshold to be used for identifying content group/category.” *See* Office Action, p. 11.

Menon fails to remedy the deficiency of *McHenry*. *Menon* discloses that “if the frequency of access of a particular content goes over a preset threshold, the system can trigger an operation that eventually results in the ‘push’ of the content from an origin server ... to the rest of the edge servers.” *Menon*, paragraph [0076]. The Office Action apparently interpreted *Menon*’s “frequency of access” and “preset threshold” as equivalent to the claimed “interest value” and “interest threshold,” respectively. *See* Office Action, pp. 11-12. Even accepting these allegations, solely for the sake of argument, *Menon* neither teaches nor suggests both “a first interest threshold and a second interest threshold greater than the first interest threshold,” as recited by amended claim 18.

Moreover, neither *McHenry* nor *Menon* teaches or suggests “identifying ... at least one first category and at least one second category, from said set of categories, when the distributed contents associated with the first category have an interest value below the first interest threshold and the distributed contents associated with the second category have an interest value that exceeds the second interest threshold,” “removing the distributed contents associated with the first category from the surrogate servers,” and “making at least one of the identified contents associated with said second category available for distribution at the surrogate servers,” as recited by amended claim 18. The Office Action alleged that content on *McHenry*’s “enterprise network edge servers” (*McHenry*, paragraph [0025]) and “origin server systems” (*id.*)

correspond to the claimed “distributed contents” and “remaining contents that have not been distributed,” respectively. *See* Office Action, pp. 9-10. Even accepting this allegation, solely for the sake of argument, *McHenry* neither teaches nor suggests removing contents from the “enterprise network edge servers” where those contents at the “enterprise network edge servers” have an interest value below a first interest threshold and making contents at the “origin server systems” available for distribution if they are associated with the same category as certain contents at the “enterprise network edge servers,” where those contents at the “enterprise network edge servers” have an interest value exceeding a second interest threshold.

Menon fares no better. *Menon* at most discloses that “if the frequency of access of a particular content goes over a preset threshold” this same content will be pushed from the origin server. *See Menon*, paragraph [0076]. Like *McHenry*, *Menon* is silent regarding removing distributed contents if they have an interest value below a first interest threshold and making undistributed contents available for distribution if they are associated with the same category as certain distributed contents that have an interest value exceeding a second interest threshold.

Ben-Shaul and *Sanfilippo*, taken either alone or in combination with any or all of the other cited references, do not cure the deficiencies of *McHenry* because they also fail to teach or suggest the above-quote claim features recited in amended claim 18. Instead, *Ben-Shaul* is merely cited for its alleged teaching of “semantics affinity” and *Sanfilippo* is merely cited for its alleged teaching that “the semantics affinity is calculated as the distance between the additional content and the reference content.” *See* Office Action, pp. 12-13. However, the Office Action does not allege so, and *Ben-Shaul* and *Sanfilippo* do not teach or suggest at least Applicants’ claimed “retrieving,” “receiving,” “identifying,” “removing,” and “making” features of amended claim 18.

Independent claim 18 and its dependent claims 24-28 and 34 should therefore be allowable over *McHenry*, *Ben-Shaul*, and *Sanfilippo*, whether these references are taken alone or in any combination. Moreover, *Liddy*, *Asadov*, and *Gruen*, whether taken alone or in any combination with *McHenry*, *Ben-Shaul*, and *Sanfilippo*, fail to cure the deficiencies of *McHenry*, *Ben-Shaul*, and *Sanfilippo*, and the Office Action does not allege that they do so. Therefore, dependent claims 24-28 and 34 are not obvious over *McHenry*, *Ben-Shaul*, and *Sanfilippo* in view of one or more of *Liddy*, *Asadov*, and *Gruen*, whether taken alone or in any combination, at least by virtue of being dependent from nonobvious base claim 18. Accordingly, Applicants request the withdrawal of the 35 U.S.C. § 103(a) rejections and allowance of these claims.

III. Conclusion:

Applicants request reconsideration of the application and withdrawal of the rejections. Pending claims 18-22, 24-28, and 34 are in condition for allowance, and Applicants request a favorable action.

The Office Action contains a number of statements reflecting characterizations of the cited references and the claims. Regardless of whether any such statements are identified herein, Applicants decline to automatically subscribe to any such statements or characterizations.

If there are any remaining issues or misunderstandings, Applicants request the Examiner telephone the undersigned representative to discuss them.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account no. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 24, 2012

By: 

David M. Longo
Reg. No. 53,235

[direct telephone: (571) 203-2763]